

REMARKS

Claims 1-20 are currently pending in the application. Claims 1 and 12 have been amended by: (a) addition of the phrase “registering policy data on a database of a service system by an advertiser through said advertising system” at Claim 1, lines 7-8, and at Claim 12, lines 8-9 (support for which amendments may be found in the Specification at page 10, lines 18-25); (b) addition of the phrase “wherein customer data is registered in relation to said user ID” at Claim 1, line 13, and at Claim 12, lines 19-20 (support for which amendments may be found in the Specification at page 15, lines 18-25); (c) insertion of the term “advertisement” in Claim 1, line 14, and in Claim 12, line 21 (support for which amendments may be found in the Specification at page 11, lines 14-25); and (d) replacement of the term “detailed data of said specific article and said user ID” with “said customer data and said policy data” at Claim 1, lines 14-15, and at Claim 12, lines 22-23 (support for which amendments may be found in the Specification at page 16, lines 8-13). In addition, “poly” has been replaced with “policy” in Claim 12, lines 10-11, to correct a typographical error. No new matter has been added.

Claims 1-8, 11-17, and 20 were rejected pursuant to 35 U.S.C. § 103(a) as unpatentable in view of U.S. Patent No. 6,230,325 to Iinuma et al. in view of “Admitted Prior Art.” (Office Action at 3) Claims 9-10 and 18-19 were rejected pursuant to 35 U.S.C. § 103(a) as unpatentable over Iinuma et al. in view of U.S. Patent No. 6,078,891 to Riordan et al. (Office Action at 4) The rejections of Claims 1-20 are respectfully traversed for the reasons that: the claimed subject matter is not suggested by the references; a person of ordinary skill in the art would not combine the references to arrive at the claimed invention; modification of the invention disclosed by Iinuma et al. as proposed by the Examiner would render it inoperable for its intended purpose; Riordan et al. teach that it may not be possible to use their invention in the manner proposed by the Examiner; the Examiner has previously improperly relied on Official Notice without citation of any reference in an area of esoteric technology; and the Examiner has engaged in impermissible

hindsight.

In essence, the rejection is based on the Examiner's conclusory assertion that prior art subsumes the claimed invention, even though such prior art does not address the fundamental characteristic of the claimed invention, which is to provide custom-selected advertising to television viewers through the interaction of multiple systems. As discussed below, the basis for the rejection appears to be impermissible hindsight cast in terms of official notice that, in effect, any use of advertising is *per se* obvious.

The Examiner's Erroneous Determination That "Multiple Systems" Are Not Claimed

Iinuma et al. teach a method and a system for making purchases, through an information network (which can be the Internet), of items promoted via television or radio broadcast. Iinuma et al. enable guide information to be displayed on users' televisions in a manner that may superficially resemble the manner in which custom-selected advertising is displayed on users' televisions in the claimed invention.

Iinuma et al. do not, however, concern the provision of custom-selected advertising. The claimed invention involves a method and a system for advertising, via a network with user ID, to viewers of broadcast programming.

The disclosure of Iinuma et al. does not teach the use of multiple systems. By contrast, independent Claims 1 and 12 expressly claim a broadcasting and delivery method and system which employs the interaction of four different types of systems to generate a customer-selected presentation of advertising to a user:

1. A bi-directional type broadcasting and delivery method, comprising the steps of:
 - (a) broadcasting a program including an advertisement program of articles from a *broadcasting system* to a user terminal, said advertisement program being produced by an advertising agent in response to a demand transmitted by an advertiser from an *advertiser system* to an *advertising agent system*;

- (b) selecting on said user terminal, a specific one of said articles in which a user has interest when said user views said advertisement program on said user terminal;
- (c) informing said selection to a *service system* through a network with a user ID;
- (d) preparing a private page for said user based on detailed data of said specific article and said user ID;
- (e) downloading said private page from said *service system* to said user terminal through said network; and
- (f) carrying out purchase or reservation of said specific article on said user terminal on which said detailed data of said specific article is displayed.

(Claim 1; prior to present amendment) (emphasis added); and

12. A bi-directional type broadcasting and delivery system, comprising an *advertiser system* of an advertiser, an *advertising agent system* of an advertising agent, a *broadcasting system* of a broadcasting company, a user terminal of a user, and a *service system* which are connected to a network, wherein said advertiser determines policy data for an advertisement program, and transmits said policy data and a demand of production of an advertisement program of articles of said advertiser from said *advertiser system* to said *advertising agent system*,
said advertising agent produces said advertisement program based on said policy data in response to the demand of production of said advertisement program, and said *advertising agent system* transmits said advertisement program and said policy data to said *broadcasting system*,
said *broadcasting system* broadcasts said advertisement program,
said user terminal receives said advertisement program from said *broadcasting system* and displays said received advertisement program, wherein a user selects a specific one of said articles in which said user has interest when said user views said received advertisement program on said

user terminal, the selection being informed to said *service system* with a user ID,

said *service system* prepares a private page for said user based on detailed data of said specific article and said user ID, and

said user terminal downloads and displays said private page from said *service system*, and said user transmits an instruction for purchase or reservation of said specific article from said user terminal to said *service system.*

(Claim 12; prior to this amendment) (emphasis added).

Language expressly claiming such multiple systems may also be found in dependent Claims 2, 4, 7, 9, 10, 11, 13-14, and 16-20. (Claim 2, lines 4, 6, 6-7, 9, and 10; Claim 4, line 3; Claim 7, line 3; Claim 9, lines 3, 5, 6, and 6-7; Claim 10, lines 6, 6-7, 7; Claim 11, line 8; Claim 13, lines 2, 3, 4; Claim 14, lines 2, 3; Claim 16, line 2; Claim 17, line 2; and Claim 20, lines 5, 6)

The claimed invention thus unambiguously employs the interaction of *multiple systems* to select and display user-tailored advertising and to present such advertising to a television viewer. Applicant respectfully submits that the Examiner has erroneously read the claims in this regard and that there is no basis for the determination that Applicant has not claimed “the use of the interaction of multiple systems to generate customer-selected presentation of advertising to a user.” (Office Action at 4-5)

Applicant thus traverses the Examiner’s conclusion that use of multiple systems is not claimed by the claimed invention. Such conclusion is contradicted by the plain language of the claims, where the interaction of four types of systems is repeatedly claimed, as discussed above. Accordingly, Applicant hereby incorporates by reference the Amendment Under 37 C.F.R. § 1.111, filed April 26, 2004, as if it were fully restated herein and requests reconsideration.

Claims 1-8, 11-17, and 20

Claims 1-8, 11-17, and 20 were rejected as unpatentable over Iinuma et al. in

view of “Admitted Prior Art,” which appears to be a reference to the representation of prior art in Figure 1 and to the description of related art in the Applicant’s specification. Applicant traverses on the basis that Claims 1-8, 11-17, and/or 20 are not suggested by either Iinuma et al. or by prior art or related art disclosed in the Applicant’s disclosure, or by any combination of Iinuma et al. and the prior or related art.

Notwithstanding such traversal, Applicant has amended Claims 1 and 12 by:

- (a) addition of the phrase “registering policy data on a database of a service system by an advertiser through said advertising system” at Claim 1, lines 7-8, and at Claim 12, lines 8-9; (b) addition of the phrase “wherein customer data is registered in relation to said user ID” at Claim 1, line 13, and at Claim 12, lines 19-20; (c) insertion of the term “advertisement” in Claim 1, line 14, and in Claim 12, line 21; and
- (d) replacement of the term “detailed data of said specific article and said user ID” with “said customer data and said policy data” at Claim 1, lines 14-15, and at Claim 12, lines 22-23. Such amendments are provided for the purpose of clarification.

The Examiner’s discussion of these claims closely tracks the language of the disclosure of Iinuma et al. but does not explain how the disclosure of Iinuma et al. may be supposed to suggest Claims 1-8, 11-17, and/or 20. The Examiner treats these claims as a group with no discussion of any specific claim or claim language, and without even employing language that tracks or paraphrases the Applicant’s claims. Thus, there is nothing in the Office Action, other than the Examiner’s conclusory assertion, to support a determination that the reference, the prior art, and/or the related art, alone or in combination, suggest any claim of the claimed invention. (In this regard please see the comments on the Examiner’s use of impermissible hindsight and improper assertion of official notice, below.) For example, by way of illustration and not limitation, while the Examiner cites Figures 10(a)-(c) of Iinuma et al. to establish that certain data “is derived from customer data” (Office Action at 3), it is not apparent how the cited figure provides support for that proposition because the figure does not refer to “customer data”:

FIG. 10(a)

GUIDE INFORMATION

BROADCASTING PROGRAM ID : 123456
DATA BASE CENTER TELEPHONE NUMBER : 03-444-5555
DATA BASE SERVER ID : http://WWW.abc.or.jp

FIG. 10(b)

USER INFORMATION

NAME : OOOO
ADDRESS : ΔΔΔΔ
USER ID : XYZ98765
PASSWORD : ****

FIG. 10(c)

COMMUNICATION INFORMATION

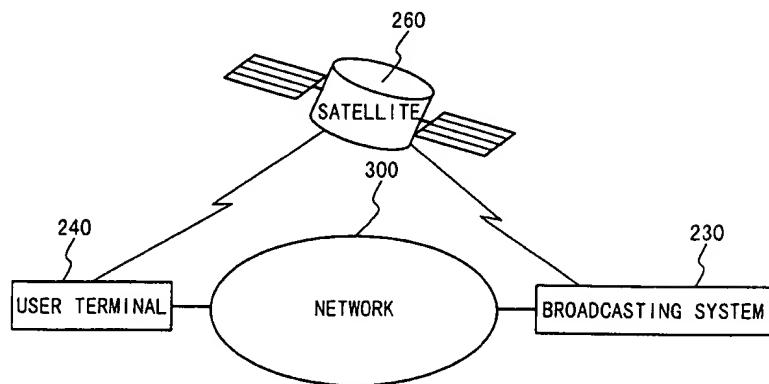
THANK YOU FOR YOUR ENJOYMENT OF ABC SHOPPING. THE FOLLOWING TWO COMMODITIES ARE AVAILABLE.
1. OOOO 2. ΔΔΔΔ
PLEASE DESIGNATE COMMODITY NUMBER: [1]
PLEASE SELECT METHOD OF PAYMENT: [2]
1. CREDIT X 2. CREDIT Y 3. CREDIT Z
PLEASE INPUT CREDIT NUMBER: 0001235678
YOUR ORDER HAS BEEN ACCEPTED. THE COMMODITIES WILL BE FORWARDED BEFORE THE DATE OF XXXX.

(Inuma et al., Figure 10(a)-(c)) Nor do Figures 10(a)-(c) of Inuma et al. otherwise appear to describe the claimed invention. Figure 10(c) of Inuma simply shows an order form, while the claimed invention enables consideration of differences in personality among users and differences in policies among advertisers.

Furthermore, the Examiner has not provided any explanation of how prior art as presented in Figure 1 or related art as described at pages 1-2 of the Applicant's

specification may be combined to suggest Claims 1-8, 11-17, and/or 20. Figure 1, by way of illustration and not limitation, provides as follows:

F i g . 1 P R I O R A R T



(Figure 1, cited in the Office Action at 3) The Office Action does not discuss how or why Claims 1-8, 11-17, and/or 20 would be suggested by Figure 1, except that Figure 1 is referenced in the Applicant's description of the related art, which contains a reference to Figure 1:

2. Description of the Related Art

A conventional commercial broadcasting and delivering method is known in which online shopping and questionnaire of an article are carried out using a satellite broadcasting and a network. In this conventional method, advertisement is carried out to a user through the satellite broadcasting and the reaction of the user to the advertisement can be acquired through the network.

Fig. 1 shows the conventional advertisement broadcasting and delivering system. In Fig. 1, the conventional broadcasting and delivering

system is composed of a user terminal 240, a broadcasting station system 230, a network 300 connected to them mutually, and a satellite 260.

An advertiser requests an advertising agency to advertise articles, and the advertising agency produces an advertisement program and transmits the produced advertisement program to the broadcasting station and requests the broadcasting of this advertisement program. The broadcasting station broadcasts the requested advertisement program to the user terminal 240 through the satellite 260 using the broadcasting station system 230.

The user of the user terminal 240 hears and views the received advertisement program. If having an interest in the article shown in the advertisement program, the user calls a dealer who sells the article, and carries out online shopping through the network 300 connected with the user terminal 240. Or, the user actually goes to a shop to purchase or reserve for the purchase. At this time, the advertisement program contents viewed and heard by the user are uniform irrespective of the attribute data such as the sexuality and age of the user.

However, there are the following problems in this conventional advertisement broadcasting and delivering system. First, advertisement effectivity data such as data indicating that the user has viewed the advertisement program or data indicating the user has wanted to view the advertisement program are not correctly managed and measured.

Also, the advertisement effectivity data are not fed back to the advertisement program contents in real time. For this reason, it is difficult to optimize the advertisement program contents or sales promotion contents such as a discount amount and a giveaway about the data of the purchase layer, customer, the time or the time zone in real time.

(Specification at page 1, line 9 – page 3, line 3) (emphasis added) Applicant is at a loss to understand the basis on which the Examiner has concluded that Claims 1-8, 11-17, and/or 20 are in whole or in part suggested by a description of related art which points out problems encountered in related art which are not encountered by the

claimed invention. Some or all of the features of some or all of Claims 1-8, 11-17, and/or 20 would not be suggested simply by virtue of the fact that it is known in related art “for an advertiser to request an advertising agency to advertise articles and for the advertising agency to produce an advertisement program, then transmit the produced advertisement program to the broadcasting station and finally, request the broadcasting of the advertisement program.” (Office Action at 3) (emphasis added) Most notably, by way of illustration and not limitation, the prior or related art does not describe the use of multiple systems in the manner of independent Claims 1 and 12 and dependent Claims 2, 4, 7, 11, 13-14, 16-17, and 20 of the claimed invention, as discussed above.

The Examiner has also incorrectly drawn an analogy between the *shopping program* of Iinuma et al. and an *advertisement*: “Iinuma does not specifically teach how or who produces the shopping program (i.e. advertisement).” (Office Action at 3) While both *shopping programs* and *advertisements* may relate to commercial uses of television, the ordinary meanings of those words are by no means the same. Therefore, to the extent the rejection is based on a determination that the terms *shopping program* and *advertisement* have the same meaning, it is based on an incorrect factual premise. Furthermore, to allow independently brokered third-party advertisements to run during a shopping program would present the risk that advertisements run during the shopping program would include advertisements of competing products. Such advertisements would defeat the purpose of a shopping program and would thus deprive the shopping program of a significant portion of the commercial value it would otherwise have. Because the addition of features of the claimed invention to the invention disclosed by Iinuma et al. would render their invention “inoperable for its intended purpose,” the disclosure of Iinuma et al. does not provide an appropriate basis for rejecting the claimed invention as unpatentable under 35 U.S.C. § 103(a). *In re Gordon*, 221 U.S.P.Q. 1125, 1127 (Fed. Cir. 1984). Applicant thus traverses the determination that “[i]t would have been obvious to a person of ordinary skill in the art at the time the invention was made to modify the shopping program of Iinuma et al.” to arrive at the claimed invention. (Office Action

at 3)

The Examiner has recognized that “Iinuma et al. does not[] specifically teach paying an advertising production fee, a broadcasting fee or charging a fee for every transaction.” Lacking a reference to make up for the deficiencies, the Examiner relies on impermissible hindsight expressed in terms of improper Official Notice:

The common knowledge or well-known in the art statement made by the Examiner in the Office Action mailed 2/13/04 is taken to be admitted prior art because applicant either failed to traverse the examiner’s assertion of Official Notice or the traverse was inadequate (MPEP2144.03(C)).

(Office Action at 3) In the response to the previous office action, Applicant traversed the Examiner’s invocation of Official Notice on the basis that assertion of Official Notice constituted impermissible hindsight and an improper assertion of technical fact in an area of esoteric technology without support by citation of any reference work, citing M.P.E.P. § 2144.03, which in turn cited *In re Ahlert*, 424 F.2d 1088, 1091, 165 U.S.P.Q. 418, 422-21 (C.C.P.A. 1970), as follows:

Claims 1-8, 11-17, and 20 were rejected pursuant to 35 U.S.C. § 103(a) as obvious in view of U.S. Patent No. 6,230,325, to Iinuma. In essence, the Examiner has asserted that the prior art, such as described in Figure 1 of the application, subsumes the claimed invention, even though the prior art does not address the fundamental characteristic of the claimed invention, which is to provide custom-selected advertising to television viewers through the interaction of multiple systems. The basis for such rejection is the Examiner’s overly broad taking of official notice that, in effect, any use of advertising is per se obvious. Applicant respectfully traverses the Examiner’s taking of official notice in this regard as impermissible hindsight and as an improper assertion of technical fact in an area of esoteric technology without support by citation of any reference work. See MPEP 2144.03 (citing *In re Ahlert*, 424 F.2d 1088, 1091, 165 USPQ 418, 422-21 (CCPA 1970)).

* * *

In rejecting claims 1-8, 11-17, and 20, the Examiner has asserted that the circumstances warrant taking official notice that

[I]t is old and well know[n] for an advertiser to request an advertising agency to advertise articles and for the advertising agency to produce an advertisement program, then transmit the produced advertisement program to the broadcasting station and finally, request the broadcasting or the advertisement program.

The “old and well know[n]” practice described by the Examiner, however, does not describe the claimed invention. The familiar practice described by the Examiner typically involves an advertising agency taking weeks or months to produce and schedule television commercials, which are subsequently shown during commercial breaks in the television programs. Such commercials are not tailored to particular viewers but are instead shown to a program’s full viewing audience. Thus, the “old and well know[n]” process described by the Examiner does not anticipate the claimed invention.

Furthermore, the Examiner’s taking of official notice in this regard is overly broad, asserts a technical fact in an area of esoteric technology without support by citation of any reference work, and is therefore traversed as discussed above. There is no basis for rejecting claims 1-8, 11-17, and 20 under 35 U.S.C. § 103(a).

(Amendment Under 37 C.F.R. § 1.111, filed April 26, 2004, at 8, 10)

Any assertion by the Examiner of Official Notice in this matter is improper, as discussed in Applicant’s response to the previous office action, because the claimed invention concerns an area of esoteric technology. Details of the matters on which the Examiner has sought to assert Official Notice do not change the fact that an area of esoteric technology is at issue. Applicant thus restates the traversal of the Examiner’s assertion of Official Notice as improper for the reasons described above.

Applicant respectfully submits that Claims 1-8, 11-17, and 20 are not suggested by Iinuma et al. and/or by admitted prior or related art, or any combination of the same.

Claims 9-10 and 18-19

The Examiner has rejected dependent Claims 9-10 and 18-19 under 35 U.S.C. § 103(a) as “unpatentable over Iinuma et al. as applied to claims 1-8, 11-17 and 20 above, and further in view of Rio[r]dan et al.” (Office Action at 4) Recognizing that “Iinuma et al. does not teach producing marketing data based on purchases made and transmitting the marketing data to advertiser in order to optimize policy data” (Office Action at 4), the Examiner relies on Riordan et al. to make up for the deficiencies.

Without citation to any particular portion of Riordan et al., the Examiner has asserted that the disclosure of Riordan et al. “teaches (*in the background*) that market research is an important business tool which permits companies to cost effectively target their marketing and sales activities and efficiently reach potential customers” (Office Action at 4, emphasis added) and that “organizations have long been known to collect marketing data by tracking sales transaction.” (*Id.*) The Examiner’s expansive reading of Riordan et al. overreaches and appears inevitably to lead to the incorrect conclusion that Riordan et al. generally anticipate any claims involving collection or use of marketing data. Furthermore, Riordan et al. teach that use of marketing data as suggested by the Examiner might not be possible because of legal or contractual limits or prohibitions on accessing purchasing information identifiable to a specific user:

It should be recognized that specific queries to data warehouse 185 may be restricted by law or for other reasons. For example, accessing customer-specific purchasing information might be prohibited by law in some states. Similarly, credit authorization location 165 might contractually obligate data warehouse 185 to limit customer-specific queries for reasons of public relations or to stop customers from abandoning payment vehicles issued by the credit authorization institution.

(Riordan et al., col. 11, lines 14-22) Adding to this the circumstance that the Examiner has proposed to employ the invention disclosed by Riordan et al. to modify Iinuma et al. in a manner that would make it inoperable for its intended purpose, as discussed above, there does not appear to be an appropriate basis for rejecting the claimed invention under 35 U.S.C. § 103(a). (*See In re Gordon*, 221 U.S.P.Q. 1125,

1127 (Fed. Cir. 1984))

Applicant respectfully submits that Claims 9-10 and 18-19 are not suggested by Iinuma et al. and/or Riordan et al.

Conclusion

In view of the foregoing, Applicant submits that all of the claims are patentably distinct from the prior art of record and are in condition for allowance. The Examiner is respectfully requested to pass the above application to issue. The Examiner is invited to contact the undersigned at the telephone number listed below, if needed.

Applicant hereby makes a written conditional petition for extension of time, if required. Please charge any deficiencies in fees and credit any overpayment of fees to Attorney's Deposit Account No. 50-2041 (Whitham, Curtis & Christofferson).

Respectfully submitted,



Michael E. Whitham
Registration No.32,635

Whitham, Curtis & Christofferson, P.C.
11491 Sunset Hills Road, Suite 340
Reston, Virginia 20190
Tel. (703) 787-9400
Fax. (703) 787-7557

CUSTOMER NUMBER 30743